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83-2045

Office - Supreme Court, U.S.

FILED

MAY 29 1984

ALEXANDER L. STEVAS

CLERK

No. _____

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1984

WILLIAM J. XANDER and JOSEPH F. NIGGEMEIER,

Petitioners,

vs.

HON. COMMISSIONER OF PATENTS AND TRADEMARKS,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Henry W. Cummings
Attorney for Petitioners

Henry W. Cummings
Attorney/Consultant
ACF Industries, Inc.
3301 Rider Trail South
Earth City, MO 63045-1393
(314)344-4211



QUESTION PRESENTED FOR REVIEW

(1) Whether the Semi-Closed Language "consisting essentially of" sanctioned by the Court of Customs and Patent Appeals in In re Garnero, 412 F(2) 276; 162 USPQ 221 (CCPA, 1969) for use in excluding unspecified chemical elements, substances and compounds from patent claims which would alter the basic characteristics of the product, should be extended to purely mechanical cases to exclude mechanical elements from patent claims which would alter the basic and novel characteristics of the mechanical assembly.

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- (A) CAFC Decision
- (B) Denial of Petition For
Reconsideration and Hearing
En Banc
- (C) Drawing of Appellant's Route Card
Holder
- (D) Pevovarchuk, U.S. Patent 1,553,472

TABLE OF AUTHORITIES

Adams v. U.S., 383 U.S. 39,; 148 USPQ 479
(1966)

Graham v. John Deere, 383 U.S. 1; 148 USPQ
459 (1966)

In re Garnero, 412 F(2) 276; 162 USPQ 221
(CCPA, 1969)

In re Rice, 481 F(2) 1316, 178 USPQ 478
(CCPA, 1973)

Southcorp v. U.S., 690 F(2) 1368; 215 USPQ
657 (CAFC, 1982)

28 USC 1254(1)

28 USC 1294 (4)(A)

35 USC 103 (1976)

Pevovarchuk, U.S. Patent 1,533,472

Pearce, U.S. Patent 2,517,235

Thomas, U.S. Patent 2,600,812

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PETITION FOR WRIT OF CERTIORARI
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I. PRAYER

The petitioners, William J. Xander and Joseph F. Niggemeier, respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit entered on February 29, 1983.

II. OPINION BELOW

The Court of Appeals for the Federal Circuit entered its memorandum decision affirming the decision of the U.S. Patent and Trademark Office Board of Appeals sustaining the Examiner's rejection under 35 USC 103 (1976) of claims 5-7 and 9 of Application Serial No. 957,493. A copy of the memorandum decision is attached as Appendix A.

The Court denied petitioner's petition for rehearing and suggestion for rehearing en banc on April 13, 1984. A copy of the order is attached as Appendix B.

III. JURISDICTION

On February 29, 1984, The Court of Appeals for the Federal Circuit entered judgment affirming the Board of Appeals of the U.S. Patent and Trademark Office decision sustaining the Examiner's rejection under 35 U.S.C. 103 (1976) that claims 5-7 and 9 of application Serial No. 957,493 are unpatentable.

The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1) and 28 U.S.C. 1295 (4)(A).

IV. INVENTION

The invention in this case is directed to a route card holder to be placed on a railway freight car to indicate the contents of the car, and the routing of the car to its destination and other pertinent information.

For reasons of economics the route card holder is formed of a single metal stamping, and consists essentially of two outer vertical webs 62 and 64 (See drawing found in the Appendix) and an intermediate vertical web 66 which is shorter than the outer vertical webs. Three horizontal webs 70, 72, and 74 are provided of equal length. The three vertical webs and horizontal webs define three unobstructed viewing areas 68, 76 and 78. A route card placed within the holder through the opening 78 is held in

place since the end vertical webs and lower horizontal web are bent 90° to support the card.

The middle horizontal web and the middle vertical web prevent the card from blowing out of the holder in windy and inclement weather.

The claims (found in the Appendix) utilize the language "consisting essentially of" to limit the number of vertical and horizontal webs to three each, and to limit the number of unobstructed viewing areas to three.

V. THE COURT OF APPEALS DECISION

The Court of Appeals for the Federal Circuit relied on Pevovarchuk, U.S. Patent No. 1,533,472 found in the Appendix to affirm the Board of Appeals decision holding the claims unpatentable under 35 U.S.C. 103 (1976).

As can be seen from the drawings of the Pevovarchuk patent, Pevovarchuk is directed to a picture frame formed of a single stamping which supports a number of photographs rather than a single card. The picture frame is intended for inside use where the problem of windy and inclement weather causing a picture to fly out of the frame would not be present. Therefore, in Pevovarchuk there is not the combination of the middle vertical web 66 and the middle horizontal web 72 located such as to hold the card in place.

In addition Pevovarchuk discloses four (4) horizontal webs and eleven (11) vertical webs instead of the three (3) horizontal and vertical webs called for in the claims on appeal.

Finally, in Pevovarchuk a single card is not supported by bent portions of the outer vertical webs and the lower horizontal web as

called for in appellants claims. Rather, in Pevovarchuk, a number of cards are supported by a number of different vertical webs.

VI. APPELLANTS CONTENTIONS

Appellants contended before the Court of Appeals that In re Garnero, 412 F(2) 276, 162 USPQ 221 (1969), which sanctioned the language "consisting essentially of" as effective to exclude additional unspecified ingredients which would affect the basic and novel characteristics of a chemical product defined in the balance of a claim should be extended to apply to a purely mechanical case such as the present case. While the product involved in the Garnero case was a thermal insulation panel, it was nonetheless defined as "consisting essentially of" expanded pearlite particles. Pearlite is a recognized chemical sub-structure. However, the claims in Garnero were directed to a thermal insulation panel which is a mechanical product.

The decisions of Court of Customs and Patent Appeals, (CCPA) have been adopted by the Court of Appeals for the Federal Circuit, as precedent Southcorp v. U.S., 690 F(2) 1368; 215 USPQ 657 (CAFC, 1982). Therefore the Garnero case is clearly appropriate precedent in the Court of Appeals for the Federal Circuit.

In the Garnero case, the CCPA held as follows, "In either event it cannot be said that the additional ingredient would not materially affect the basic and novel characteristics of appellant's product which is that the pearlite particles are held together without any additional material."; and that the "consisting essentially of" language was sufficient to exclude the sodium silicate binder of Thomas, U.S. Patent 2,600,812, and the hydrated lime in U.S. Patent 2,517,235 to Pearce.

VII. QUESTION PRESENTED FOR REVIEW

Should the partially closed language "consisting essentially of" sanction in In re Garnero be extended to purely mechanical cases to exclude additional unspecified mechanical elements which would affect the basic and novel characteristics of the product defined by the mechanical elements in the claims.

In the present case the language "consisting essentially of" is believed to limit the product claimed to the three horizontal webs, and the three vertical webs, with the middle vertical web being shorter to define three unobstructed areas 68, 76 and 78 within which to read the route card; and to define the middle vertical member 66 and the middle horizontal member 72 which hold the card in place in windy and inclement weather.

It is believed that if the semi-closed "consisting essentially of" language were to

be applied to the Pevovarchuk reference, this language would exclude the fourth horizontal web, and particularly would exclude the eleven vertical webs. It would also exclude the fourteen unobstructed areas which are present in the Pevovarchuk reference to house fourteen (14) individual cards. (Emphasis added)

It should also be born in mind that Pevovarchuk, is intended for holding of pictures or postcards indoors. The pictures and/or postcards are prevented from falling out only at the sides and at the bottom. There is no protection against the pictures fourteen (14) being blown out in windy weather as is present with appellant's middle vertical web 66 and middle transverse web 72. It is thus seen that the Pevovarchuk structure does not recognize or solve the problem of holding cards in place in an external encasement in windy or inclimate

weather which was solved by appellant's structure. It therefore is believed that the Court of Appeals for the Federal Circuit erred in holding that the invention on appeal was obvious under 35 U.S.C. 103. Graham v. John Deere, 383 U.S. 1 (1966); U.S. v. Adams, 383 U.S. 39; 148 USPQ 479 (1966); In re Rice, 481 F(2) 1316, 178 USPQ 478 (CCPA, 1973).

VIII. REASON FOR EXTENDING IN RE GARNERO TO MECHANICAL CASES

As is illustrated by the comparison of the route card holder called for in the claims on appeal as compared to Pevovarchuk, it is a reasonably common problem in mechanical cases to provide language in mechanical claims which distinguishes the structure to be patented from the structure shown in existing references. This is particularly true when the invention involves simplification of one or more previously existing mechanical devices or mechanical process steps.

If the Court were to hold that the semi-closed "consisting essentially of" language sanctioned in In re Garnero may also be applied to purely mechanical cases, the problem of providing suitable language in mechanical claims which differentiates simplified devices over prior more complicated devices would be significantly reduced.

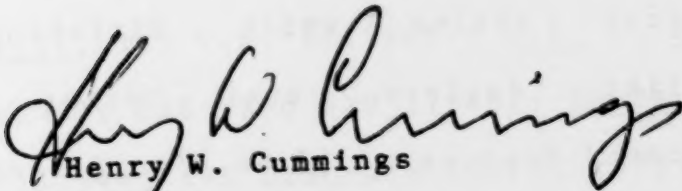
The Court of Appeals decision failed to address this issue in its opinion.

IX. CONCLUSION

It therefore is urged that this Court either (i) grant certiorari to consider the question of whether the semi-closed language sanctioned in In re Garnero should be extended to purely mechanical cases to distinguish simplified mechanical structure over existing more complicated prior art structures containing a number of additional mechanical elements; or (ii) remand the case

to the Court of Appeals for the Federal
Circuit for consideration of this issue.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Henry W. Cummings". The signature is fluid and cursive, with the first name "Henry" and last name "Cummings" clearly distinguishable.

Attorney/Consultant

ACF Industries, Inc.

3301 Rider Trail South

Earth City, Mo. 63045-1393

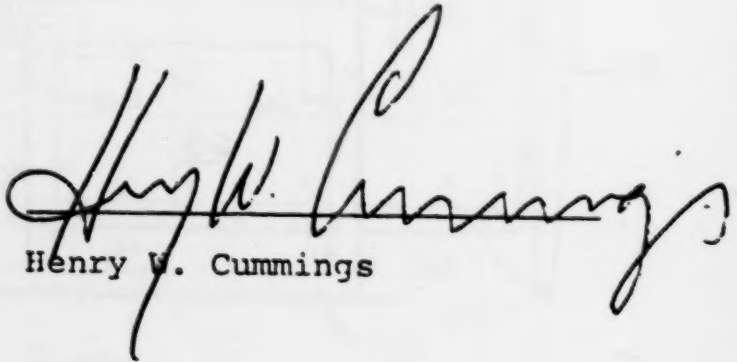
(314) 344-4211

May 22, 1984

HWC/lg

IX. CERTIFICATION

It is hereby certified that three copies of this revised Petition for Certiorari have been mailed to the Solicitor General, Department of Justice, Washington, D.C. 20530; and Joseph F. Nakamura, Solicitor of the U.S. Patent and Trademark Office, P.O. Box 15667, Washington, D.C. 22215, this 8th day of June, 1984.


Henry W. Cummings

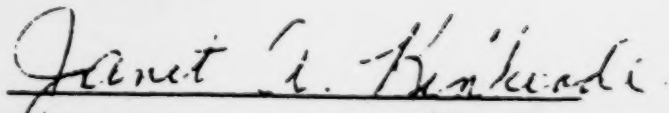
State of Missouri)

)

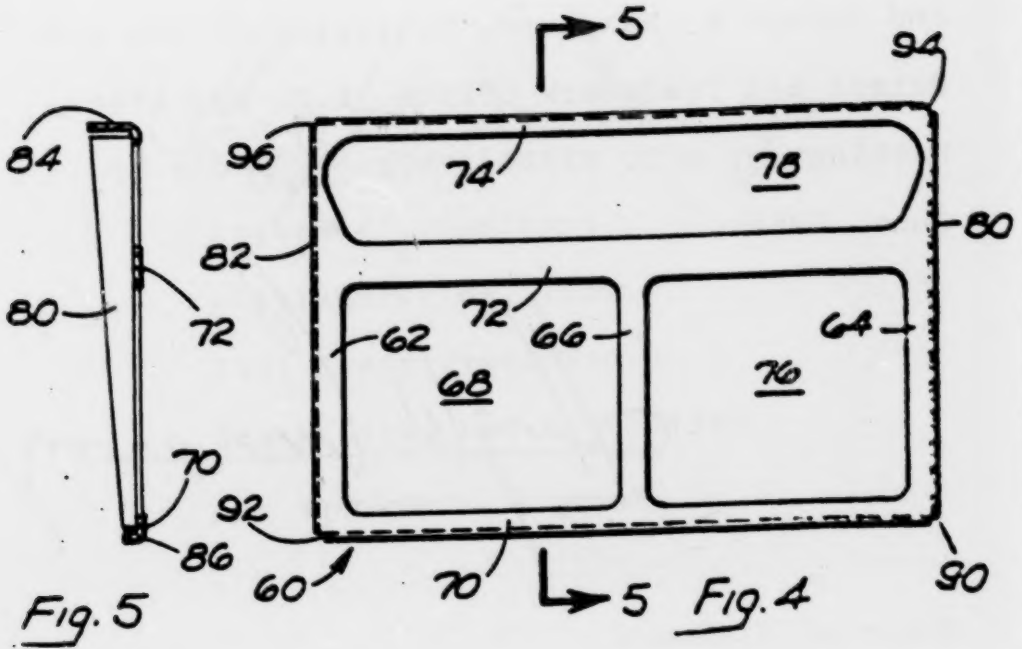
County of St. Charles)

Subscribed and sworn to before me this 7th day of June, 1984.




Notary Public

JANET A. KINKEADE
NOTARY PUBLIC STATE OF MISSOURI
ST LOUIS CO.
MY COMMISSION EXPIRES MAY 2 1987



AU 333

EX

OR

1,553,472

Case 552

Ref. A

May 20, 1863.

J. A. PEVOVARCHUK

1,553,472

PICTURE FRAME

Filed March 25, 1925

Fig. 1.

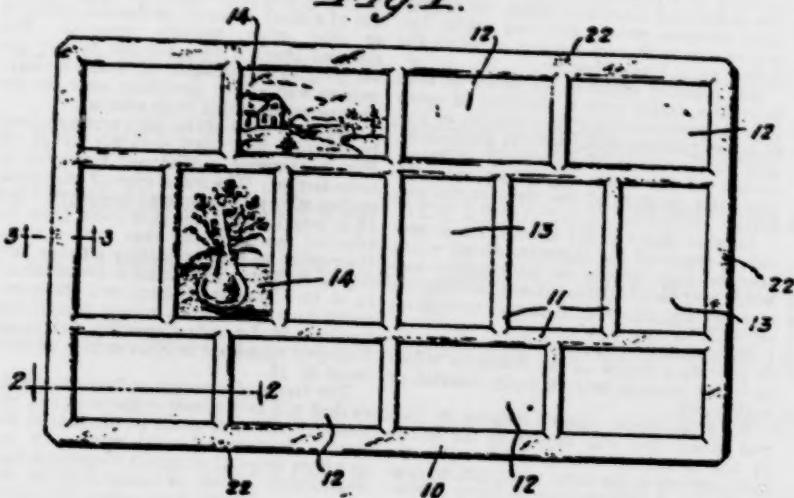


Fig. 2.

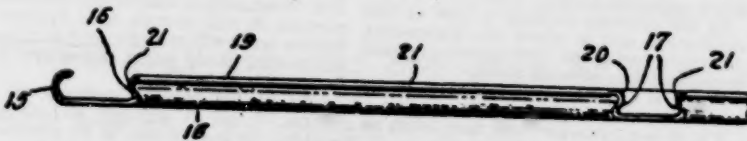
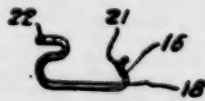


Fig. 3.



Inventor:
J. A. Perovarchuk
By J. Pelchowiez
Attorney.

BEST AVAILABLE COPY

Patented Sept. 15, 1925.

1,553,472

UNITED STATES PATENT OFFICE.

JOHN A. PEVOVARCHUK, OF CHICAGO, ILLINOIS.

PICTURE FRAME.

Application filed March 25, 1923. Serial No. 19,364.

To all whom it may concern:

Be it known that I, JOHN A. PEVOVARCHUK, a citizen of Ukraine, residing at Chicago, in the county of Cook and State of Illinois, have invented certain new and useful improvements in Picture Frames, of which the following is a specification.

The primary object of the invention is to provide a frame with a plurality of openings or partitions wherein a number of pictures of uniform size, such as post cards, may be positioned longitudinally or transversely of the frame depending upon the respective position of the views in the pictures.

Another object of the invention is to provide a frame of the character stated which may be very simple in construction and which may be easily manufactured by being stamped out of sheet of metal, cardboard, celluloid or the like.

Still another object of the invention is to provide a frame of the character stated in which pictures may be easily inserted or withdrawn.

With the above general objects in view and others that will appear as the nature of the invention is better understood, the same consists in the novel construction, combination and arrangement of parts hereinafter more fully described, illustrated in the accompanying drawing and pointed out in the appended claim.

In the drawing forming a part of this application, and in which like designating characters refer to corresponding parts throughout the several views, Fig. 1 is a front elevational view of the frame;

Fig. 2 is a cross-sectional view taken on line 2—2 of Fig. 1; and

Fig. 3 is a cross-sectional view taken on line 3—3 of Fig. 1.

Referring to the drawing there is shown the outer frame section 10 with partition strips 11, said outer frame section and said partition strips being in symmetrical relation and forming a plurality of openings, some of said openings being positioned longitudinally of the frame as indicated by 12 and the remaining openings being laid transversely of the frame as at 13. Picture cards such as 14 are positioned within the two series of openings, either lengthwise or cross-wise, depending upon the views repre-

sented thereupon, as is obvious from the drawing.

The complete frame, including the outer section 10 and partition strips 11, is stamped out of a sheet of metal, cardboard, celluloid or any other suitable material. The stamped blank is then suitably formed for the purpose of giving to the frame a thickness as well as for providing seats for the picture cards within each opening.

The outer edge of the outer section is bent backwardly and then inwardly as at 15, Fig. 2, assuming a U-shaped formation in cross-section. The inner edge of said outer section adjacent the several openings 12 and 13 is bent backwardly, then away from the adjacent openings, and then toward them, the portion so bent presenting a flange having an S-shaped formation in cross-section, as at 16. The longitudinal and transverse partition strips 11 are similarly formed, the portions so formed presenting flanges of S-shaped formation in cross-section as indicated by 17.

The frame constructed as hereinabove described will have a neat appearance and will present itself as if made of substantial material. Portions of outer section 10 and partition strips 11 at points wherefrom they immediately project, as indicated by 18, will prevent the pictures from falling forwardly, while the ends 19 of the flanges will provide backward supports for the picture cards. The intermediate, outwardly protuberant portions 20 will provide seats wherein the picture cards will rest, the position of one of the picture cards being represented by a broken line 21 in Fig. 2.

One of the upright portions of said flanges 16 and 17 adjacent each series of openings 12 and 13 has, in its protuberant portion 20, a longitudinal slot 21 for inserting the picture cards within the openings.

Portion 15 of the outer section 10 has several outwardly projecting ears 22, each ear being provided with an aperture for the purpose of attaching a wire or cord by means of which the frame may be suspended on the wall.

While there is described herein a preferred embodiment of the present invention it is nevertheless to be understood that minor changes may be made therein without departing from the spirit and scope of the invention as claimed.

1,553,472

What I claim as new is:

A picture frame comprising an outer section, a series of longitudinal and transverse strips, said outer section and said strips being arranged to form a plurality of uniform openings, some of said openings having a longitudinal relation in respect of the frame and other openings having a transverse relation in respect thereof for the purpose of receiving therewithin picture cards of uniform size and accommodating them in said openings longitudinally or trans-

versely of the frame depending upon the relative position of the respective views upon said cards, flanges upon said section and said strips surrounding each opening, said flanges being formed backwardly of the plane of the frame, and seats in said flanges for positioning picture cards thereupon, one of the upright portions of said flanges adjacent each opening having slots for insertion of picture cards therethrough.

In testimony whereof I affix my signature.

JOHN A. PEVOVARCHUK.

V. APPELLANT'S APPENDIX

(A) The Claims

5. A route card holder consisting essentially of a stamping from a single piece of metal; said stamping consisting essentially of a pair of end vertical webs and a center vertical web located between and being shorter than said end vertical webs; said holder including lower and intermediate horizontal webs integral with said three vertical webs; and an upper horizontal web joining only said end vertical webs; a pair of laterally spaced unobstructed lower cut out portions defined solely by said lower and intermediate horizontal webs, said center vertical web and one each of said end vertical webs; an unobstructed upper cut out portion defined solely by said upper and intermediate horizontal webs and said end vertical webs; said end vertical webs and said lower horizontal web bent approximately 90°

to define supports for the route card; said route card adapted to be attached to a railway freight car; whereby said route card may be inserted into said upper cut out portion, and said horizontal webs and said end vertical webs hold the card in place, and whereby said card may be easily read by virtue of said lower cut out portions and upper cut out portion.

6. A route card holder according to claim 5, wherein said upper horizontal web is also bent approximately 90° to aid in maintaining said route card in place.

7. A route card holder according to claim 5, wherein the upper and lower horizontal webs are provided with slots to facilitate drainage.

9. A route card holder consisting essentially of a stamping from a single piece of steel and plated with zinc for resistance to

corrosion; said stamping consisting essentially of a pair of end vertical webs and a center vertical web located between and being shorter than said end vertical webs; said holder including lower and intermediate horizontal webs integral with said three vertical webs; and an upper horizontal web joining only said end vertical webs; a pair of laterally spaced unobstructed lower cut out portions defined solely by said lower and intermediate horizontal webs, said center vertical web and one each of said end vertical webs; an unobstructed upper cut out portion defined solely by said upper and intermediate horizontal webs and said end vertical webs; said end vertical webs and said lower horizontal web bent approximately 90° to define supports for the route card; said route card adapted to be attached to a railway freight car; whereby said route card may be inserted into said upper cut out portion, and

said horizontal webs and said end vertical webs hold the card in place, and whereby said card may be easily read by virtue of said lower cut out portions and upper cut out portion.

Note: This opinion will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals for
The Federal Circuit

In re WILLIAM J. XANDER) Appeal No. 83-1361
and JOSEPH F. NIGGEMEIER)
)
)
) Serial No. 957,493

DECIDED: February 29, 1984

Before DAVIS, SMITH, and NIES, Circuit Judges.
SMITH, Circuit Judge.

DECISION

The decision of the U.S. Patent and Trade-mark Office Board of Appeals (board), sustaining the rejection under 35 U.S.C. Sec. 103 (1976) of claims 5-7 and 9 of application serial No. 957,493, is affirmed.

OPINION

Xander argues that the "consisting essentially of" recitation of the appealed claims serves to limit the claims to a specific number of openings. The examiner and the board, however, found that Pevovarchuk, U.S. patent No. 1,553,472, discloses a frame stamped from a single piece of metal having an unspecified number of openings. The limitation of the appealed claims to only three openings fails to distinguish the appealed claims from Pevovarchuk under section 103.

We agree with the board that it would have been obvious to one of ordinary skill in the art

to provide a frame with any number of unobstructed openings in which the end webs are bent rearward at a 90 degree angle for support.

Xander argues that the board's reliance on the examiner's name plate was improper because the name plate was not shown to have been available as prior art and because it is not properly combined with Pevovarchuk. We find it inappropriate, however, to rule on the issue of availability of the name plate as prior art in that a ruling on that issue is unnecessary to our decision. The examiner found that the end webs were bent rearward at a 90 degree angle for support and aesthetic reasons. We hold that the formation of the end web would have been obvious to one of ordinary skill in the art.

Hence, the board's rejection of claims 5-7 and 9 is affirmed.

United States Court of Appeals for

The Federal Circuit

IN THE MATTER OF THE

No. 83-1361

APPLICATION OF

Serial No. 957,493

WILLIAM J. XANDER and

JOSEPH F. NIGGEMEIER

Judgment

ON APPEAL from the US Patent and Trademark

Office - Board of Appeals

This CAUSE having been heard and considered,
it is

ORDERED and ADJUDGED: AFFIRMED

DATED February 29, 1984 ENTERED BY ORDER

OF THE COURT

George E. Hutchinson, Clerk

Signed: George E. Hutchinson, Clerk

ISSUED AS A MANDATE: March 22, 1984

A True Copy.

Attests

Signed: N. Richard Sienbiewich

Deputy Clerk

UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

717 Madison Place, N.W.

Washington, D.C. 20439

April 13, 1984

George E. Hutchinson

Telephone 633-6550

Clerk

Area Code 202

Mr. Henry W. Cummings

3301 River Trail South

Earth City, Missouri 63045-1392

In Re: William J. Xander and

Joseph F. Niggemeier

Appeal No. 83-1361

Dear Mr. Cummings:

The Court has today denied appellants' motions to file out of time a Petition for Rehearing and Suggestion for Rehearing In Banc and to Vacate the Mandate in this appeal.

Copies of the Petition are being returned under separate cover.

Very truly yours,

Signed: George E. Hutchinson

Under Separate Cover:

Petition

cc: Robert D. Edmonds, Esq.

